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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------|------------------|
| 10/022,439 | 12/20/2001 | Stanley E. Rockabaugh | 19860.00 | 5109 |

37833 7590 11/17/2003

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EXAMINER

DEL SOLE, JOSEPH S

ART UNIT PAPER NUMBER

1722

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,439

Applicant(s)

RODABAUGH, STANLEY E.

Examiner

Joseph S. Del Sole

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. In the Applicant's response of 9/26/03 the Applicant requested that a Notice of Draftsperson's review be included with the next Office action. It is the policy of the Office to only have drawings reviewed once a Notice of Allowability is deemed appropriate. However, the Examiner has found no objections to the drawings.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sheffield (5,035,056).

Sheffield teaches a device having a base member (Fig 2, #27), the base member having an outer planar arcuate surface (Fig 2, bottom) and an inner planar arcuate surface (Fig 2, top), a length, a width, a first end and a second end (Fig 1); means for rocking the base member back and forth (Fig 2, #30) on the outer planar arcuate surface; a first handle member (Fig 2, #30 on the left) disposed at the first end on the

inner planar arcuate surface and extending substantially vertically upward therefrom; a second handle member (Fig 2, #30 on the right) disposed at the second end on the inner planar arcuate surface and extending substantially vertically upward therefrom; wherein the first handle member and the second handle member are of rounded configuration (Fig 2); the base member, the first handle member and the second handle member are of one-piece construction (col 2, lines 41-44); the base member, the first handle member and the second handle member are fabricated from plastic (col 2, lines 31-44).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheffield (5,035,056) in view of Haley et al (5,830,049).

Sheffield teaches the device as discussed above, the device also having a base member (Fig 2, #27), the base member configured as a semi-circle having an inner circumferential surface (Fig 2, the top), an outer circumferential surface (Fig 2, the bottom), a length, a width, a first end and a second end (Fig 1a first handle member (Fig 2, #30 on the left) disposed at the first end on the inner circumferential surface; a second handle member (Fig 2, #30 on the right) disposed at the second end on the inner circumferential surface; wherein the first handle member and the second handle member are of rounded configuration (Fig 2); and the base member, the first handle member and the second handle member are of one-piece construction (col 2, lines 41-44).

Sheffield fails to teach the one piece construction fabricated from wood.

Haley et al teaches a one piece construction fabricated from wood for the purpose of holding a cutting implement (col 3, lines 48-53).

It would have been obvious to one having ordinary skill in the art at the time of the Applicant's invention to have modified the invention of Sheffield with the one piece construction being made of wood as taught by Haley et al because both constructions are for controlling a cutting implement and wood is a heavy duty material, interchangeable with plastic, that is long lasting and easy to clean (col 3, lines 48-53).

7. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheffield (5,035,056) in view of Ricard et al (5,431,078).

Sheffield teaches the device as discussed above, the device also having a base member (Fig 2, #27), the base member configured as a semi-circle having an inner

circumferential surface (Fig 2, the top), an outer circumferential surface (Fig 2, the bottom), a length, a width, a first end and a second end (Fig 1a first handle member (Fig 2, #30 on the left) disposed at the first end on the inner circumferential surface; a second handle member (Fig 2, #30 on the right) disposed at the second end on the inner circumferential surface; wherein the first handle member and the second handle member are of rounded configuration (Fig 2); and the base member, the first handle member and the second handle member are of one-piece construction (col 2, lines 41-44).

Sheffield fails to teach the one piece construction fabricated from wood.

Ricard et al teaches a one piece construction fabricated from wood for the purpose of holding a cutting implement (col 4, lines 33-48).

It would have been obvious to one having ordinary skill in the art at the time of the Applicant's invention to have modified the invention of Sheffield with the one piece construction being made of wood as taught by Ricard et al because both constructions are for controlling a cutting implement and wood is a heavy duty material, interchangeable with plastic, that is long lasting and easy to clean.

Response to Arguments

8. Applicant's arguments filed 9/26/03 have been fully considered but they are not persuasive.

As discussed in the interview of 10/28/03, the rejections drawn to Gibran et al, Watson, Rhoades et al, Peirce and Ehren have been overcome by amendment.

The Applicant argues that Sheffield does not teach handles as claimed by the Applicant.

The Examiner disagrees. The handles of Sheffield are disposed on either end (left and right of Figure 2) of the device and divide the apparatus into (and therefore extend from) inner (top of Figure 2) and outer (bottom of Figure 2) arcuate surfaces; additionally, the handles extend in two direction, including out of the paper (Fig 1) and are also bent in a direction from the outer surface to the inner surface (Fig 2).

Therefore, the handles as claimed are taught by the Sheffield reference.

The Applicant argues that the device of Sheffield is used to slice bananas.

While this is true, Sheffield still teaches the device as claimed.

Allowable Subject Matter

9. Claim 8 is allowed.
10. Claims 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
11. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or suggest a device of the parent claims fabricated from marble.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph S. Del Sole whose telephone number is (703) 308-6295. The examiner can normally be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for both non-after finals and for after finals.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Joseph S. Del Sole

J.S.D.
November 10, 2003



ROBERT DAVIS
PRIMARY EXAMINER
GROUP 1200-1722

11/12/2003